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09/651,428	08/30/2000	Brian Berson	1697P	2572

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Sawyer Law Group LLP
P O Box 51418
Palo Alto, CA 94303

EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,428

Applicant(s)

BERSON ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/26/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 9/26/05 to the application filed on 8/30/00.
2. Claims 1-20 are pending in the case. Claims 1, 9, and 15 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Pat No. 6,278,465 B1, 8/21/01, filed 6/23/97).

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Regarding independent claim 1, Nielsen discloses:

- forming a database of font specifications (col 5, line 53 to col 6, line 27 and figure 5B, #524, #528, figure 5C, #542, #548: the Font Size Preference Database storing Font Sizes which are font specifications shows that such a font database is formed)
- accessing the database when opening documents to ensure usage of proper fonts (**figure 4 and col 5, lines 14-28: querying the Size Preference Database** when the *user access a URL* inherently shows accessing the Size Preference Database for querying, and opening documents when a URL is accessed)
- accessing the database when saving documents to ensure usage of proper fonts (**figure 5C, #542-550 and col 5, line 53 to col 6, line 2: if the user chooses** “Yes” to the question “Do you want *the page displayed with the current font size from now on*”, then the *URL and the preferred size are added to the Font Size Preference Database as a new record* if no record exists for this URL or as a *change to the existing record if one does exists*; adding the URL and the preferred size as *new record to the Font Database* or adding the URL and the preferred size as a change to the existing record if one does exist to the Font Database implies *accessing the Font Database to check the existence of the current font size in the database* and to *determine* that the URL and the preferred size is *a new record or merely a change*; adding the URL for the page along with the preferred font size to the Font Database so *that the page is displayed with*

the current font size "from now on" implies saving the page with the preferred size to use from now on)

- the font specification includes at least one attribute (col 5, line 53 to col 6, line 27 and figure 5B, #524, #528, figure 5C, #542, #548: the font size is one attribute of the font specification)

Nielsen does not disclose that the font specifications including at least two attributes of a font. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated the font style as a second attribute to the font specification with one attribute in Nielsen since it was well known in Word that a font specification basically includes the font style. The combination of such a font specification with at least two attributes to Nielsen would provide more choices to users in presenting various characteristics of a document.

Regarding claim 2, which is dependent on claim 1, Nielsen discloses accessing the database when storing further comprising obtaining a font list for a document being saved, and determining whether font specifications for each font in the font list exist in the database (figure 5C, #548 Ask user if new font size should *be recorded or not in Preference Database* where the database includes a font list for documents; figures 3A, 3C).

Regarding claim 3, which is dependent on claim 2, Nielsen discloses that when the font specifications do exist, the method further comprises retrieving the font specifications

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for each font from the database (figure 4, #410 URL found in size preference DB?, #430 Display file using the font stored in database: the fact that the system checks to see if the URL found in size preference database and if yes, displays file using the font stored in the database shows that the font specification of said URL in conjunction with the URL is retrieved for displaying file using said font stored in the database; col 5, lines 14-28).

Regarding claim 4, which is dependent on claim 3, Nielsen discloses that when the font specifications do not exist, the method further comprises creating the font specifications for each font (figure 5C, #548 and col 7, lines 45-59: the fact that if the URL does not currently exist in the font size preference database, the user is asked if *the new font size* should be recorded in the Font Size Preference Database shows a creating of the font specification for a new font for a file document).

Regarding claim 5, which is dependent on claim 4, Nielsen discloses writing the font specifications into the document, and saving the document (figure 5C, #542-#554: if the URL is not in the font preference database, then *the new font is recorded* for the document in the preferred font size database; this shows that the preferred font size, which is the font specifications for the document referred by the URL, is written to the document and saved in the database with the URL).

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Regarding claim 6, which is dependent on claim 1, Nielsen discloses accessing the database when opening documents further comprises retrieving font specifications from a document being opened (figure 4; col 5, lines 14-28: “ .. if the URL was found in the Size Preference Database then the requested document is displayed using the preferred font size retrieved from the database ...”; displaying the requested document implies that the document is accessed).

Regarding claim 7, which is dependent on claim 6, Nielsen discloses searching the database to locate each font specified by the font specifications in the document (col 5, lines 14-28: the fact that based on the query, the URL was found in the Size Preference Database shows searching the database is carried out to locate the font specification for the document; “if the URL was not found in the Size Preference Database 410, *then a search (see FIG. 8) is made of the Sub-Site Database ...*”).

Regarding claim 8, which is dependent on claim 7, Nielsen discloses retrieving each font located (col 5, lines 14-28: the font for the requested document is retrieved either in the Size Preference Database or the Sub-Site Database).

Claims 9-14, 15-20 are for a system and a computer readable medium of method claims 1-8, and are rejected under the same rationale.

Response to Arguments

6. Applicant's arguments filed 9/26/05 have been fully considered but they are not persuasive.

Applicants argue that Nielson (used in 102(e) rejections) does not disclose accessing the font database when saving documents to ensure usage of proper fonts since the recording feature pointed in Nielsen is for recording fonts, not for recording the document (Remarks, page 8).

Examiner respectfully disagrees.

The rejections of claims 1-20 in the previous action are under 35 U.S.C. 103 (a), not 102 (e) as mentioned by Applicants.

Nielson discloses accessing the font database when saving documents (col 5, line 53 to col 6, line 2) since when answering "Yes" to the question "Do you want the page displayed with the current font size from now on?", that means the page is saved with the current font size at that time. *In order to recognize whether said font is a new record or a change of the existing fonts, accessing the Font Database must be performed to compare the current font with the fonts in the Font Database*. Therefore, it is clear that Nielson discloses accessing the font database when saving a document to ensure usage of proper fonts.

Applicants argue that Nielsen expects users to modify the font pointsize, thereby changing the way a document is imaged for comfortable viewing whereas the invention is about never changing the way a document is imaged (Remarks, page 8).

Applicants' arguments are not persuasive since Nielsen does teach the claimed limitations as mentioned in the rejections.

Applicants also argue that Nielsen does not disclose that the font specifications including at least two attributes of a font as in claims 1, 9, and 15. See these claim rejections for this argued feature.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Burns (US Pat No. 6,460,040 B1, 10/1/02, filed 1/6/00, priority 2/27/97).

Gauthier (US Pat No. 6,381,028 B1, 4/30/02, filed 4/26/99, priority 7/18/97).

Miller et al. (US Pat No. 6,512,522 B1, 1/28/03, filed 4/15/99).

Ying et al. (US Pat No. 6,853,980 B1, 2/8/05, filed 9/7/99).

Matsuo et al. (US Pat No. 6,775,729 B1, 8/10/04, filed 11/24/99).

Chan et al. (US Pat No. 6,073,147, 6/6/00, filed 6/10/97).

Flowers, Jr. et al. (US Pat No. 5,533,174, 7/2/96).

Cohen et al. (US Pat No. 6,510,426 B1, 1/21/03, filed 9/30/98).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
Art Unit 2178
10/16/05